

Remarks

The Examiner's Office action mailed May 18, 2005, which allowed pending claims 1 and 43 and withdrew pending claims 2-42 and 44-84, has been reviewed. In view of the following remarks, Applicant respectfully submits that all claims in the application should have been examined, and all are in condition for allowance.

Applicant thanks the Examiner for the allowance of claims 1 and 43.

The Examiner withdrew claims 2-42 and 44-84 from consideration. The Examiner claimed that these claims are directed to an invention that is independent or distinct from the invention originally claimed because: claims 2-35 and 44-77 are directed to a frame system and claims 36-42 and 78-84 are directed to a squeegee frame for a squeegee. The Examiner found that all of the claims are related as combination/subcombination with claims 1 and 43.

The Examiner further found that since applicant received an action on the merits for the originally presented invention, this invention has been constructively elected by original prosecution on the merits. Accordingly, claims 2-42 and 44-84 are withdrawn from consideration as being directed to a non-elected invention under 37 C.F.R. § 1.142(b) and MPEP § 821.03. The Examiner then closed the prosecution of the application on the merits under Ex parte Quayle.

Applicant does not agree that a restriction is proper or should have been made. Applicant does not agree that a constructive election of any claims has been made. However, regardless of whether or not a restriction is proper, the Examiner erred by withdrawing claims 2-42 and 44-84.

The Examiner incorrectly withdrew claims 2-42 and 44-84. The Examiner called Applicant's attorney, Jim Stipek, and told Applicant's attorney that the claims were directed to three groups of inventions (Group I-claims 1 and 43; Group II-claims 2-35 and 44-77; and Group III-claims 36-42 and 78-84), that the application was subject to restriction, and that Group I was in condition for allowance. The Examiner requested a verbal election of one of the three groups. Applicant's attorney told the Examiner that claims 1 and 43 were linking claims, that the claims in Groups II and III were encompassed by the Examiner's search of Group I, and a verbal election was not appropriate. The above-referenced Office action followed.

Under MPEP 803, an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)). However,

if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP § 803.

Under MPEP § 809, where linking claims are found, restriction can nevertheless be required. See MPEP § 809.03 for definition of linking claims.

However, under MPEP § 809, a letter including only a restriction requirement or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered linking. “The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn.” MPEP § 809. “Any claim(s) directed to the nonelected invention(s) must be rejoined and will be fully examined for patentability.” MPEP § 809.

The Examiner did not send a letter stating that the claims in Group 1 were linking claims. Nor did the Examiner acknowledge that the claims in Group I were linking claims in the telephone interview. The Examiner erred by not specifying that claims 1 and 43 were linking claims when the Examiner restricted the claims.

Under the Examiner’s Quayle action, the linking claims in Group I are allowable. Under MPEP § 809, should any linking claims be allowed, the restriction requirement must be withdrawn, and the claims directed to the non-elected invention must be rejoined and fully examined. Therefore, the Examiner must rejoin claims 2-42 and 44-84 and examine them under MPEP § 809. Providing a Quayle action advising Applicant of the allowance of claims 1 and 43 and requiring Applicant to cancel the remaining claims was improper. Applicant requests that claims 2-42 and 44-84 be reinstated and examined in accordance with MPEP § 809.

The Examiner’s reliance on 37 C.F.R. § 1.142(b) and MPEP § 821.03 to make this Quayle action is misplaced. MPEP § 821.03 states “Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.” 37 CFR § 1.145 states “If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.”

If the Examiner finds that the amended claims are directed to three groups and the first group was presented prior to an action on the merits, the Examiner can restrict the application to Group I under MPEP § 821.03. However, MPEP § 821.03 does not alleviate the Examiner's responsibility under MPEP § 809 to find that the claims in Group I are linking claims, to reinstate the remaining claims when the linking claims are found to be allowable, and to examine the reinstated claims.

The claims in Groups II and III are encompassed by the search completed for Group I. Therefore, the examination of the entire application can be made without serious burden under MPEP § 803. For example, independent claim 2 is directed to a system for printing with a squeegee and a screen comprising an MRS frame, a track system, and a height adjustor. Dependent claim 4 is directed to the squeegee comprising a squeegee frame, a blade, at least one angle adjustor, and at least one guide member. Independent claim 36 is directed to a squeegee operable for manually printing with a screen, etc. and comprising, among other things, a blade, at least one angle adjustor, and at least one guide member. Independent claim 1 is directed to a system operable with a manual printing press and a screen and comprising a frame system comprising an MRS frame, a track system, and a height adjustor and a squeegee comprising a squeegee frame, a blade, at least one angle adjustor, and at least one guide member.

The Examiner cannot claim that there is any more of a burden required to examine these claims. The Examiner cannot claim that claims 1 and 43 are not linking claims for all groups or that examination of all claims should not be made hereunder. An additional search is not required.

Applicant requests that claims 2-42 and 44-84 be reinstated and examined in accordance with the MPEP.

Regarding Comments on Statement of Reasons for Allowance, Applicant notes that Reasons for Allowance are not required under MPEP § 1302.14. Under MPEP § 1302.14, if the examiner believes that the record of the prosecution *as a whole* does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning.

Applicant submits that the prosecution record as a whole makes clear sufficient reasons why each of the claims is allowable and that such a statement is not warranted in this case. Applicant does not agree with any reason for allowance or any characterization of any reference. Applicant does not acquiesce that the claim features or other characterizations identified in the

Reasons for Allowance are or are not necessary for patentability or are or are not present in any particular claim. The reasons for allowance are not accurate and precise and place unwarranted interpretations on the claims.

The references cited by the Examiner and made of record have been reviewed by Applicant. Applicant has no further remarks with regard to cited references.

Based on the foregoing, it is submitted that the Applicant's invention as defined by the claims is patentable over the references of record. Issuance of a Notice of Allowance is solicited.

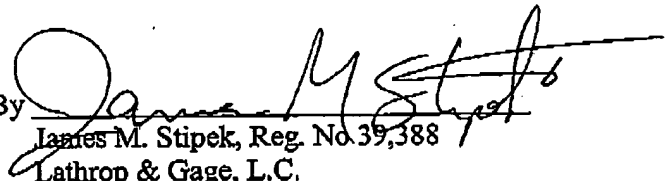
Applicant's attorney welcomes the opportunity to discuss the case with the Examiner in the event that there are any questions or comments regarding the response or the application.

This is intended to be a complete response to the Examiner's Office action mailed on May 18, 2005.

Respectfully Submitted,

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